

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

Claims 1, 3-6, 9 and 10 were rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over Reetz et al. ("Reetz"), *Angew. Chem. Int. Ed.*, 39: 3889-3890 (2000). In response, Applicants submit the attached Declaration of Dr. Manfred T. Reetz. Dr. Reetz is not only the first named inventor on the instant application, but is also the first named author on the Reetz article relied on by the Examiner. Thus, Dr. Reetz has unique knowledge not only of the subject matter of the instant application, but also of the content of the Reetz article.

The Examiner draws a distinction in the second paragraph on page 3 of the final rejection between the constitutionality of enantiomers versus that of diastereomers. In response, Applicants direct the Examiner's attention to numbered paragraphs 11-23 of the Reetz Declaration, explaining in great detail that compounds 8a and 8b of the Reetz article have the same constitution, i.e., they are not constitutionally different as required by the instant claims. In view of this evidence, Applicants respectfully submit that the Reetz article does not anticipate the instant claims.

The Examiner attempts to make out a *prima facie* case of obviousness in the last paragraph on page 3, arguing that the use of two different diastereomeric ligands would "either complement or block the approach to the metal center by a substrate, and the skilled artisan would readily appreciate that in *some* instances, using *certain* reagents, a mixture of two different ligands or diastereomeric ligands, would increase the activity and/or stereoselectivity of the catalyst for a given prochiral reagent." Applicants respectfully submit that this is all highly speculative, and is not sufficiently set forth in the prior art itself that persons skilled in the art could be said to have been motivated to make the modifications needed in the Reetz article to achieve the present invention with a reasonable expectation of success. Thus, the Examiner does not identify either the

instances where the reagents needed to be used to obtain the hypothesized increase in activity and/or stereoselectivity. In the absence of such information, no person having ordinary skill in the art could reasonably have been expected to be successful in such endeavor.

Applicants remind the Examiner that the Federal Circuit very recently in *Ortho McNeil Pharmaceuticals, Inc., v. Mylan Laboratories, Inc., et al.*, --- F.3d ---, 2008 WL 834402 (Fed. Cir. 2008), confirmed that “a flexible TSM test *remains* the primary guarantor against a non-statutory hindsight analysis such as occurred in this case (emphasis added).” According to the Court, “[t]he TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of *evidence*—teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)—that arise before the time of invention as the statute requires (again, emphasis added).” *Id.*

There is no teaching or suggestion in Reetz to use constitutionally different ligands, nor has the Examiner put forth any other evidence of motivation. Indeed, by teaching the use of constitutionally identical ligands, the Reetz article actually leads way from the use of constitutionally different materials.

Applicants refer the Examiner to numbered paragraphs 24-40 of the Reetz Declaration, explaining why the many experimental results in the specification do, in fact, prove a surprising and unexpected result. There is nothing in Reetz that teaches or suggests to persons skilled in the art that the use of constitutionally different ligands should significantly improve enantiomeric excess (“ee”) values in a high number of instances. Yet, this is exactly what is proven by the data in the instant specification. These data, then, are proof of a surprising and unexpected result, which must also be taken as objective evidence of nonobviousness. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claim 11 was rejected under 35 USC § 103(a) as being obvious over Reetz in view of Claver et al. (“Claver”), *Chem. Comm.*, 961-962 (2000). In response, Applicants point out that this rejection was premised upon Reetz either anticipating or rendering obvious the basic aspects of claim 1. However, as it has been shown above that Reetz does not anticipate or render obvious the basic aspects of claim 1, Applicants respectfully submit that this rejection should also be reconsidered and withdrawn. Indeed, nothing in Claver overcomes the above-noted defects in Reetz. An early notice that this rejection also has been reconsidered and withdrawn is, therefore, earnestly solicited.

Claims 1, 3-6 and 9-11 were rejected on the ground of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 7 and 10 of U.S. Patent No. 7,265,237. In response, Applicants point out that they previously asked for clarification of the reasoning behind this rejection. See the third paragraph on page 13 of the amendment filed November 29, 2008. The Examiner has not provided such clarification, consequently, Applicants are at a loss to understand the theory how these claims are rejected over US 7,265,237.

Claims 1, 3-6 and 9-11 were rejected on the ground of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 7 and 10 of U.S. Patent No. 7,265,237 in view of Reetz. In response, Applicants, again, note that Reetz does not describe constitutionally different ligands. Consequently, Applicants respectfully submit that the combination of US 7,265,237 and Reetz does not teach or suggest the present invention. If anything, the combination teaches and suggests the use of Reetz’s constitutionally identical ligands.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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